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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,787	06/26/2003	Richard D. Lee	FINEL:63549	6894

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FULWIDER PATTON LEE & UTECHT, LLP  
HOWARD HUGHES CENTER  
6060 CENTER DRIVE  
TENTH FLOOR  
LOS ANGELES, CA 90045

EXAMINER

WRIGHT, ANDREW D

ART UNIT PAPER NUMBER

3617

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/608,787

Applicant(s)

LEE ET AL.

Examiner

Andrew Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/30/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Specification*

1. The amendment filed 7/27/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant amended the specification and drawings to overcome a 35 USC 112 1<sup>st</sup> Paragraph rejection of claims 19-22. Applicant states that support for the amendments is in original claims 19-22 (Remarks of 7/27/04, pp 11-12). The original disclosure does not support the amendment. For example, regarding figure 2 of the amendment, there is no support for which exhaust side (port or starboard) goes to the back of the boat and which goes vertical. And there is no support for showing the relation of pipes (32' and 34') with respect to valves (38, 40) and hull (12). These relationships are depicted in figure 2, but not supported by the original disclosure. Therefore proposed figure 2 adds new matter. Furthermore, regarding the amendment to the specification, the amendment reads that "primary exhaust conduit 34', having a rear exhaust port 36', is connected to the muffler collector, and a secondary exhaust conduit 30', having a vertically directed exhaust port 32', is likewise connected to the muffler collector." This specificity of structure and connections is not supported by the broad language of original claims 19-22.

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### ***Drawings***

2. The drawings were received on 7/27/04. These drawings are not approved.

Proposed new figure 2 adds new matter and therefore has not been entered.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the combination of primary exhaust directed to the rear of the boat, secondary exhaust directed in a vertical direction, a valve means comprising first and second valves, and a means for linking the valves (claim 19) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of

the drawing figures. If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 19-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement rejection of the Office Action of 4/21/04 is repeated. Applicant's amendment of 7/27/04 does not overcome the previous rejection because it adds new matter.

6. Claims 19-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 19 was amended by the amendment of 7/27/04 to include recitations regarding a valve means. Original claim 19 only recited a valve for diverting exhaust. Amended claim 19 recites a valve means with a first valve and a second valve and associated functional language. This is new matter that is not

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 5-7, 10-12, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Polakowski (US 6,135,834). Regarding claim 1, First conduit (82) has port side outlet at port side sponson (32). Second conduit (80) has starboard side outlet at starboard side sponson (34). Both conduits are connected to exhaust manifold (164) (see figure 11). Valve means (86 and 92) for directing the exhaust are connected to the conduits. The valve means comprises first valve (92) connected to the first conduit (82) and second valve (86) connected to the second conduit (80). Valve means also comprises a means for linking the valves so that opening of one causes closing of the other such that more exhaust is directed to one side of the boat than the other. Means for linking comprises link (170). Specifically, valve (86) has moveable member (104) and valve (92) has moveable member (112). Starting with the linkage in the center (or neutral position), moving of the linkage (170) clockwise closes one moveable member (104) while leaving the other (112) in the open position. Starting with the linkage in the center (or neutral position), moving of the linkage (170) counter clockwise closes moveable member (112) while leaving member (104) open. But starting with the linkage (170) in the fully rotated clockwise position, and rotating it through center (i.e. neutral) to the fully rotated counterclockwise position takes the valves from the state of

member (104) open and member (112) closed to the state of member (104) closed and member (112) open. Therefore, the linkage is opening the first member (112) and closing member (104). Therefore, the linkage (170) constitutes a means for linking the valves such that opening one closes the other.

9. Regarding claim 2, the conduits include connecting portions (166, 168). Figure 11 shows a 90° connection between the conduits (166, 168) and the manifold (164)

10. Regarding claim 5, the means for linking comprises mechanical linkage (170) between the valves.

11. Regarding claim 6, valve control means comprises handle bar (38) and cable (60). The control means directs more exhaust to one side or the other of the boat.

12. Regarding claim 7, the means for linking comprises mechanical linkage (170). Handlebar (38) and cable (60) are a mechanical control that is connected to the linkage for controlling the valves.

13. Polakowski as described above with respect to claims 1, 2, and 5-7 contains all of the recited elements of claims 10-12 and 14-16.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 4, 13, 8, 9, 17, and 18 are rejected under 35 U.S.C. 103(a) as being

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does not disclose that the embodiment of figure 11 can be used with electrically controlled valves and an electrical switch. Polakowski does disclose that an earlier embodiment (figure 8) can utilize either mechanical valves and controller or electrical valves and control electronics including a switch (column 7, lines 20-40). Based upon the teaching of equivalence in the earlier embodiment, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the embodiment of figure 11 by using electrical valves and control electronics. Polakowski teaches that a major advantage (i.e. motivation) is the ability to electrically control the valves.

16. Regarding claims 8, 9, 17, and 18, Polakowski does not explicitly disclose the recited method steps. The steps, however, are inherent in the making and use of the Polakowski apparatus as described above. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to devise the claimed method steps based upon the making and use of the Polakowski apparatus. The motivation would be to use the Polakowski apparatus.

### ***Response to Arguments***

17. Applicant's arguments filed 7/27/04 have been fully considered but they are not persuasive. Applicant, though the amendment of 7/27/04, has amended claim 1 to contain the content of original claim 3. Applicant argues that Polakowski does not teach, disclose or suggest that opening of one of the valves closes the other (Remarks of 7/27/04, page 12). This is not persuasive. As already described, starting with the



neutral) to the fully rotated counterclockwise position takes the valves from the state of member (104) open and member (112) closed to the state of member (104) closed and member (112) open. Therefore, the linkage is opening the first member (112) and closing member (104). Therefore, the linkage (170) constitutes a means for linking the valves such that opening one closes the other.

18. Applicant repeats this argument for independent claim 10 (Remarks, page 13) and independent claims 8 and 17 (Remarks, page 14). The argument is not persuasive for these claims for the same reason that it is not persuasive for claim 1.

### ***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number (703) 308-6841. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at (703) 308-0230. The fax number for official communications is 703-872-9306. The fax number directly to the examiner for unofficial communications is 703-746-3548.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright  
Patent Examiner  
Art Unit 3617

*AW 10/13/04*  
**ANDREW D. WRIGHT**  
**PRIMARY EXAMINER**